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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,945	07/24/2003	Dennis J. Jones JR.	60073.0004US01	3664
23859	7590	01/11/2006	EXAMINER	
NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/627,945

Applicant(s)

JONES, DENNIS J.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-28-2005 has been entered.

### ***Response to Amendment***

Claims 45-53 are pending and claims 54-67 are canceled.

### ***Oath/Declaration***

2. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. Applicant submitted a preliminary amendment filed 10-26-2004, which is not a part of the original disclosure and further contains new matter. Therefore, a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01, 602.02 and 608.04(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 45 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claim 45 states the phrase "in a concentration of from greater than 0 pbw" wherein said phrase is not disclosed in the specification and may include proportions not described by applicant at the time the application was filed.

6. Claim 45 further states that the gallic acid content is "based on the weight of tannic acid", which is considered by the examiner to be a new matter statement.

Applicant is correct in stating that during the interview this question was raised and the examiner suggested clarifying the matter, however, it is the examiner opinion that the specification is clear that the gallic acid content is based on the tannic acid and the skilled artisan would reasonably infer the weight of the composition comprising the tannic acid having a gallic acid content of less than 3 is supported by the specification. Therefore, the amended phrase is redundant and raises the issue of new matter.

7. Claim 53 states the phrase "0.0001 pbw to about 5.0 pbw", wherein said phrase is not disclosed in the specification and may include proportions not described by the applicant at the time the application was filed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 45-50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lathauwer (5,738,688).

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De Lathauwer discloses a method of treating fibers or yarns comprising applying compositions containing tannic acid in an amount from 0.01 to 0.9% by weight of the acid content (col. 2, line 23) and potassium antimony tartrate (col. 3, lines 39-40). De Lathauwer further teaches that said composition may contain condensation products of sulphonated phenols (col. 2, lines 24-25) and polyacrylic acids (col. 3, line 23) and that the compositions have a pH of between 2.5 to 5.

De Lathauwer is silent with respect to the gallic acid content.

It would have been obvious to one of ordinary skill in the art, absent a showing to the contrary, to optimize the gallic acid content limitation of tannic acid because the prior art of record teaches and invites the inclusion of any commercial tannic acid. For it is held that "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382.

12. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamblin (4,482,646).

Gamblin discloses an ink or dye bath comprising 0.0001% by weight of tannic acid and 25 to 100% by weight of water (col. 3, lines 53-67).

Gamblin is silent with respect to the gallic acid content.

It would have been obvious to one of ordinary skill in the art to optimize, absent a showing to the contrary, the gallic acid content limitation of tannic acid because optimization of components is within the level of ordinary skill. Moreover, it is held that

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“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages” Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382.

13. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fekete (4,0984,701).

Fekete discloses an aqueous composition for cleaning tin surfaces comprising tannic acid in an amount from 0.01% by weight and greater (see col. 3, lines 1-8 and examples).

Fekete is silent with respect to the gallic acid content.

It would have been obvious to one of ordinary skill in the art to optimize, absent a showing to the contrary, the gallic acid content limitation of tannic acid because optimization of components is within the level of ordinary skill. Moreover, it is held that “The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages” Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382.

14. Claim 51 and 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Lathauwer (5,738,688) in view of Jones, Jr. (5,520,962).

Jones, Jr. discloses a method and composition for increasing the repellency on carpet and carpet yard comprising fluorochemicals in the amount from 0.0035 and 0.175 wt. of the solids (col. 3, lines 20-26).

Absent a showing to the contrary, It would have been obvious to one of ordinary skill in the art to incorporate the fluorochemicals taught by Jones, Jr. into the compositions taught by De Lathauwer because it is well known in the art to apply fluorochemicals coatings to nylon fabrics to provide stain repellency and De Lathauwer main objective is to improve stain resistance on fibers (see abstract).

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 45-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 62-67 of U.S. Patent No. 5,520,962 in view of De Lathauwer (5,738,688). The claims overlap in subject matter pertaining to composition to treat stains comprising a stain resistant compound and De Lathauwer teaches that tannic acid aids in improving repellency. Therefore, the skilled artisan would have been motivated to include tannic acid to aid in stain resistance.



***Response to Arguments***

17. Applicant's arguments filed 10-28-2005 have been fully considered but they are not persuasive.

Applicant argues that Gamblin or De Lathauwer do not suggest the gallic acid content of the claimed invention.

The examiner contends that the gallic acid content of the tannic acid components of Gamblin or De Lathauwer are silent, however, the burden is upon applicant to prove otherwise and it well known to the skilled artisan to optimize percentages, since gallic acid is acquired by the hydrolysis of tannic acid it would have been within the level of the skilled artisan to arrive at the gallic acid content absent a showing to the contrary commensurate in scope with the claimed invention. Moreover, by stating that any commercially available tannic acid can be used is a reasonable assumption that tannic acids of a range of gallic acid contents could be employed in a beneficial or synergistic manner.

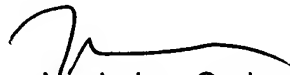
"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Necholus Ogden  
Primary Examiner  
Art Unit 1751

No  
1-7-2006